

REMARKS

Upon entry of the present election, Applicant will have elected with traverse the invention defined as Group I and species I comprising at least claims 11-21 and 32-34. However, Applicant notes that should the Examiner not withdraw the restriction requirement with regard to these two groups, Applicant reserves the right to have any withdrawn dependent claims rejoined pursuant to M.P.E.P. Section 821.04, if and when the claims of Group I are found allowable.

In the restriction requirement, the Examiner set forth a requirement to restrict the claimed invention to one of two groups of distinct inventions under the provisions of PCT Rules 13.1 and 13-2. Additionally, the Examiner indicated that Applicant must further elect one of two species shown in Figs 1-2 and Fig. 6. Applicant notes that the correct standard for supporting a restriction requirement in this application is PCT Rule 13.1 and 13.2 (MPEP sections 1850 and 1893.03(d)) by establishing that the claims lack the same or corresponding special technical feature. The groups delineated by the Examiner are as follows:

Group I, claims 20 and 21, asserted to be drawn to the species shown in Figs. 1 and 2; and

Group II, claims 22 and 23, asserted to be drawn to the species shown in Fig. 6.

The Examiner asserted that the inventions of Groups I and II, while apparently

acknowledging that they have more than one same or a corresponding technical feature (i.e., all of the features recited in independent claim 11 are common to these claims), was nevertheless asserted to be restrictable because generic independent claim 11 is not patentable over DE 31 38 510. The Examiner also asserted that the “species are deemed to lack unity of invention because they are not so linked as to form a single inventive concept under PCT Rule 13.1”

Notwithstanding the fact that the Examiner has based the restriction requirement on the correct standard enunciated in PCT rules 13.1 and 13.2 pursuant to MPEP sections 1850 and 1893.03(d), Applicant respectfully submit that the restriction requirement is improper and respectfully traverses the restriction requirement.

Additionally, Applicant submits that the Examiner’s basis for the restriction is improper for the following reasons: first of all, the Examiner has failed to properly construe and consider the claims under the “special technical feature” standard and, furthermore, based upon this standard, the restriction is clearly improper. The standard, as described clearly in M.P.E.P. sections 1850 and 1893.03(d), is not whether one group of claims has a feature which is not in another group (as erroneously asserted in this case) or whether a particular feature of one claim may be found in the prior art, but whether the groups can be read to have a common technical relationship, i.e., whether a special technical feature is

common to the groups. Accordingly, if each of the groups can be read to have one or more common special technical features or relationships, then they simply cannot be restricted.

In this case, the technical relationship or technical features common to both groups I-II has been clearly acknowledged by the Examiner, i.e, one or more features recited in generic claim 11 are clearly common to claims 20-23 since these claims all depend therefrom. Thus, there are at least as many common special technical features or relationships as there are features in claim 11.

Applicant emphasizes that each claim group clearly recites at least one common special technical feature or relationship with regard to one or more features of claim 11. Moreover, each claim group also requires a system for locking the two bars together. Additionally, Applicant takes issue with the Examiner's clear mis-characterization of the common special technical feature as something which is recited in one claim group and lacking in another claim group. This is clearly not the correct standard and, indeed, completely disregards the term "common" in a legal standard which requires "a common special technical feature." Thus, it is submitted that the Examiner has clearly disregarded both the correct legal standard and the claim language in an erroneous attempt to support the restriction requirement that is otherwise clearly improper under PCT Rules 13.1 and 13-2.

Further, M.P.E.P. 1850 paragraph "A" makes clear that dependent claims cannot be

*PCT case not valid*

separated from Independent claims because the “unity of invention” standard must be evaluated on the basis of *independent claims only*. Accordingly, since the only independent claims are 11, 33 and 34, since these independent claims have been acknowledged to be generic, and since claims 20-23 depend from these claims, none of the claims can be properly restricted as species under the unity of invention standard. Applicant emphasizes that any species election, much less, one that is based upon the specification disclosure, is an improper basis for restriction under the unity of invention standard.

Applicant emphasizes that the Examiner’s indication that species I can be distinguished from species II because it recites a feature which is not found in species II and vice versa is erroneous. As indicated above with regard to groups I and II, this is clearly an incorrect application of the unity of invention standard which requires that the claims have a common special technical feature or relationship, not that they additionally recite a feature which is not also recited in another group.

Accordingly, Applicant submits that under the “unity of invention” standard, the Examiner has set forth no proper basis for restricting the invention to any of the groups or species.

Applicant further points out that all of the claims clearly relate to a common subject matter as discussed above. Accordingly, the recitations of each of the independent claims,

as well as the various dependent claims are so closely related for examination purposes as to make the restriction requirement entirely inappropriate under any proper basis. For this reason alone, it is submitted that restriction is inappropriate and that all the claims in the present application should be examined together.

Furthermore, it is believed that the features described in each of Groups I-II are not materially different, so as to constitute distinct inventions, for examination purposes. As the Examiner must acknowledge, they all relate to a flexible container having two rigid bars and a system for locking the two rigid bars together at both of their ends. Therefore, the searches must be at least somewhat overlapping for the groups. Thus, no undue burden is placed on the Examiner when examining all of the claims together. Consequently, it is believed that all the claims, i.e., claims 11-34 relate to a single inventive concept which share a common technical relationship.

Finally, the restriction requirement set forth by the Examiner omits one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. As set forth in M.P.E.P. § 803 "an appropriate explanation" must be set forth by the Examiner as to the existence of a "serious burden" if the restriction were not required. By virtue of the Examiner's requirement and because the claims of the various groups are so closely related, i.e, they have a technical relationship related to at least one

See 804.01(a) <sup>for</sup>  
Species  
808.01(a)

common feature, it is submitted that there is no serious burden on the Examiner in examining all of the claims together. Furthermore, as noted above, the search for all of the claims includes at least some amount of overlap. Thus, no serious burden would come to bear on the Examiner.

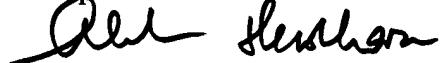
For all these reasons, and consistent with the office policy as set forth in M.P.E.P. § 803, 1850 and 1893.03(d), Applicant respectfully requests that the Examiner reconsider the position taken in the above-mentioned Official Action and withdraw the restriction/election requirement in the present application. Accordingly, the Examiner's restriction requirement is believed to be improper and has been traversed for the reasons set forth above.

Nevertheless, in order to be fully responsive, Applicant has elected with traverse the invention defined by the Examiner as Group I, species I, directed to at least claims 11-21 and 32-34 in order to be fully responsive and in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

The Commissioner is hereby authorized to charge any fees necessary for consideration of this paper to deposit account 19-0089.

Should the Examiner have any questions or comments regarding the present response or this application, the Examiner is respectfully invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,  
Jacques DENKO

  
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